REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks and the above amendments. This response is believed to fully address all issues raised in the final Office Action mailed September 24, 2007. Furthermore, no new matter is believed to have been introduced hereby.

Claims 1-52 were previously pending and remain pending in this application.

Initially, the undersigned would like to thank the Examiner for removing the outstanding objections to claims and rejections under 35 USC §§101 and 112.

35 USC §§102 and 103 Rejection of the Claims

Claims 1-2, 4-12, 14-19, 21-24, 26-34, 36, 38-39, 41-42, 44-45, and 47-51 were rejected under 35 USC § 102(e) as being anticipated by Robert et al. (U.S. Publication No. 2004/0003296 A1).

Claims 3, 13, 20, 25, 35, 37, 40, 43, 46, and 52 were rejected under 35 USC § 103(a) as being unpatentable over Robert et al. (U.S. Publication No. 2004/0003296 A1) in view of Murase et al. (U.S. Patent No. 6,298,042 B1).

Each of these rejections is respectfully traversed.

First, the Office States that:

> 5. Applicant argues Robert fails to teach selective determination. Examiner respectfully disagrees. Robert discloses the physical layer transceiver "configured to select, in order of descending priority, 100Base-TX, full duplex, 100Base-TX, half duplex, 10BaseT, full duplex, or 10BaseT, half duplex" ([0019], ln. 1-7), where the physical layer transceiver and a corresponding link partner are determining the rate of transmission through such a selection ([0019], ln. 1-7).

However, Applicant has not merely argued that Robert fails to teach "selective determination." See, e.g., previous response at pages 13-14, where Applicant states that:

> **As can be readily seen, the cited portion of Robert fails to teach (or even suggest) the claimed combination of features such as set forth in claim 1 including "selectively determining a new transmission speed different from a current**

transmission speed between a local network device and a linked network device in response to a speed change event." For example, Robert fails to teach any selective determination whether or not it is in response to a speed change event.

The cited portion of Robert merely states that:

> [0019] The PHY 16 typically is configured for performing autonegotiation with a link partner, where the PHY 16 and the corresponding link partner determine the highest data rate for transmission; for example, during autonegotiation the PHY 16 may be configured to select, in order of descending priority, 100Base-TX, full duplex, 100Base-TX, half duplex, 10BaseT, full duplex, or 10BaseT, half duplex.

As can be seen, Robert at least fails to teach or suggest "selectively determining ... in response to a speed change event."

The Office goes on to state that:

> Additionally, Applicant argues Robert fails to disclose transmitting a speed change request and the new transmission speed to the linked network device or maintaining a linked exchange. Examiner respectfully disagrees. The transmission of a speed change request and the new transmission speed have been disclosed by Robert as discussed in the preceding paragraph (see Abstract, ln. 6-10; [0023], ln. 1-3; [0024], ln. 1-5). Furthermore, the link exchange inherently is maintained as Robert discloses autonegotiation between link partners ([0023], ln. 3-10), which is an exchange across a link.

However, the Office has failed to indicate how Robert anticipates the claimed transmission of a new transmission speed. In previous sections discussed above, the Office appears to indicate that Robert only transmits a "power down request" and not the claimed "new transmission speed." Hence, a case for prima facie rejection has not been made by the Office.

Furthermore, Applicant respectfully disagrees that the link exchange inherently is maintained. In particular, Applicants assert that the record fails to provide any factual support for a finding of teaching by inherency. To prove inherency, the Examiner must establish that the Robert necessarily includes the limitation regarding transmission "while maintaining a linked

exchange between the local and linked network devices" recited in the claims. Continental Can Co. U.S.A. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). There is no such showing on the record.

In fact, Robert teaches away from maintaining a linked exchange because step 34 specifically indicates that autonegotiation (which the Office equates to the linked exchange as indicated in the above cited portion) is to be restarted. See, e.g., Figure 2 of Robert. It is respectfully submitted that restarting the autonegotiation specifically counters the claimed combination of features set forth in claim 1, e.g., including "wherein the transmitting occurs while maintaining a linked exchange between the local and linked network devices."

Accordingly, it is respectfully submitted that claim 1 is in condition for allowance.

All remaining independent claims have been rejected for similar reasons as claim 1 (see, outstanding Office Action) and these claims which recite similar (though not identical) language should be allowable for at least similar reasons as claim 1.

Also, all pending dependent claims should be allowable for at least similar reasons as their respective independent claims, as well as additional or alternative elements that are recited therein but not shown in the cited prior art.

Finally, the Office appears to reject some of the claims (as detailed in the outstanding Office Action) by inherency. However, pursuant to MPEP §2112, it is respectfully submitted that the record fails to provide any factual support for a finding of teaching by inherency. In particular, MPEP §2112 in part states that:

> **The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.**

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (720-840-6740) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-4238.

Respectfully submitted,

DAVID L. CHALUPSKY

By his Representatives,

CUSTOMER NUMBER: 50890

Telephone Number: 720-840-6740

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By /Ramin Aghevli/
Ramin Aghevli
Reg. No. 43,462